

## **REMARKS**

Claims 22-60 are pending in the Application. Claims 22-32, 34-47, 49-58, and 60 stand rejected, and claims 33, 48, and 59 are objected to in the Office action mailed April 14, 2009. Claims 22, 33, 36, 46, 47, and 50-60 are amended by this response solely at the requirement of the Office. Claims 22, 36, and 50 are independent claims from which claims 23-35, 37-49, and 51-60 depend, respectively. Applicants respectfully request reconsideration of pending claims 22-60, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

## **Objections to Claims**

Claims 50-60 were objected to due to informalities. Applicants have amended claims 50-60 to replace the phrase "machine-readable" with the phrase "computer-readable," solely at the requirement of the Office. Applicants respectfully submit that these amendments to claims 50-60 do not add new matter, nor give rise to any estoppel. Applicants respectfully submit that the objection to claims 50-60 is thereby overcome.

Claims 22-60 were objected to due to informalities. The Office states, in part at pages 2-3:

In these claims the recitation of the phrase(s) like "capable of packetizing" and "buffer capable of storing" and "interface circuitry capable of communicatively coupling" and "processor capable of arranging the transmission" etc., do not positively recite the claim limitations because the use of the word "capable" appears to make the claim to not perform the intended functionality or produce expected result. Therefore it is respectfully suggested that appropriate corrections are made to these claims without the use of word "capable".

Applicants respectfully disagree with the assertion by the Office that the use of the phrase "capable of" does not positively recite the claim limitations, or "make the claim to not perform the intended functionality or produce the desired result," as asserted. To be "capable of" a given action, the claim element must have the required functionality available when the action is to be performed, and such functionality is not optional, nor does it make the claim "to not perform the intended functionality or produce the desired result," as asserted. Notwithstanding the above, Applicants have amended claims 22, 33, 36, 46, 47, and 50 as shown above to avoid the use of the phrase

“capable of,” solely at the requirement of the Office. Applicants respectfully submit that these amendments to claims 22, 33, 36, 46, 47, and 50 do not add new matter, nor give rise to any estoppel. Applicants respectfully submit that the objection to claims 22-60 is thereby overcome.

### **Rejection of Claims**

Claims 22, 36, and 50 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No. 5,726,984. Claims 23, 24, 29-32, 34-37, 42-46, 49, 50, 54-57, and 60 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, et al. (US 5,526,353, hereinafter “Henley”) and Chan, et al. (US 5,559,861, hereinafter “Chan”). Claims 25, 26, 38, 39, 51, and 52 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Chan, and Heath, et al. (US 5,231,646, hereinafter “Heath”). Claims 27, 28, 40, 41, and 53 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Heath, Chan, and Avery, et al. (US 5,287,384, hereinafter “Avery”). Claims 47 and 58 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Chan, and Sharman, et al. (US 5,774,854, hereinafter “Sharman”). Applicants respectfully traverse the rejections.

**I. Claims 22, 36, And 50 Are Not Rendered Unpatentable Over Claims 1-25 Of U.S. Patent No. 6,850,510 In View Of Claims 1-21 Of U.S. Patent No. 5,726,984**

Claims 22, 36, and 50 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No. 5,726,984.

According to M.P.E.P. §804(II)(B)(1), "...the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)." The M.P.E.P. further states:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

(emphasis added)

In addition, M.P.E.P. §804(II)(B)(1)(a) states, in part, "...[u]nless a claimed invention in the application would have been anticipated by, or obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made...."

Applicants respectfully note that, according to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of

obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Applicants respectfully submit that the Office has not established a *prima facie* case of either anticipation or obviousness with respect to independent claims 22, 36, and 50, or any claims that depend therefrom, over the cited claims of U.S. Patent Nos. 6,850,510 and 5,726,984.

With regard to independent claim 22, the Office action sets for the following, at pages 3-4:

Claim 22,36,50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No. 5,726,984.

Regarding claim 22, A voice communication circuit comprising: at least one processor capable of packetizing digitized voice information to produce at least one voice packet **(Mobile terminal circuit and access point circuit capable of transmitting and receiving both voice and data messages, claims 16, 21 of US Pat: 6,850,510)**; a buffer capable of storing the at least one voice packet **(buffer that stores digital voice information, claim 1, lines 1-5, of US Pat: 5, 726, 984)**; interface circuitry capable of communicatively coupling the buffer with one of a plurality of interchangeable network interfaces, each of the plurality of interchangeable network interfaces supporting communication of voice packets via an associated type of communication network **(supporting at least two communication protocols for hardwired network and wireless network to exchange analog voice and digital data packets between mobile device and stationary network device, claim 11 of US Pat: 6,850,510 and claim 1, lines 29-42, of US Pat: 5, 726, 984)**; the at least one processor capable of determining the associated type of communication network supported by the one of the plurality of interchangeable network interfaces in communication with the interface circuitry **(claim 6 of US Pat: 6,850,510 and claim 1, lines 22-28, of US Pat: 5, 726, 984)**; and the at least one processor capable of arranging the transmission of

voice packets via the one of the plurality of interchangeable network interfaces based upon the associated type of communication network (**claim 6 of US Pat: 6,850,510 and claim 15 of US Pat: 5, 726, 984**).

Therefore it would have been obvious for one of the ordinary skill in the art at the time the invention to combine the claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No. 5,726,984 for exchange of data in interchangeable networks with wireless network, stationary data network and public switched network as claimed in the instant application. One is motivated as such in order to provide a modular interface circuitry to transmit packets over plurality interchangeable interfaces to a network.

(emphasis in original)

Applicants respectfully note that claims 36 and 50 are rejected based upon references to many of the same portions of the cited patents using the same rationale set forth above in the rejections of claim 22.

Initially, Applicants respectfully note that the Office does not assert that the cited patents claim identical subject matter, yet the Office also fails to make clear, “[t]he differences between the inventions defined by the conflicting claims” by comparing “a claim in the patent compared to a claim in the application,” as required by M.P.E.P. §804(II)(B)(1). Further, the Office does not provide “[t]he reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent,” also as required by M.P.E.P. §804(II)(B)(1). Instead, the Office merely repeats the text of claim 22, interspersed with citations to the identified patents, and then sets forth the conclusory statement that “[t]herefore it would have been obvious for one of the ordinary skill in the art at the time the invention to combine the claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No.

5,726,984 for exchange of data in interchangeable networks with wireless network, stationary data network and public switched network as claimed in the instant application.”

Applicants respectfully note that M.P.E.P. §804(II)(B)(1)(a) states, in part, “[u]nless a claimed invention in the application would have been anticipated by, or obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made....” Applicants respectfully submit that this requirement of the M.P.E.P. is not met by a mere conclusory statement by the Office that “[t]herefore it would have been obvious...” In addressing obviousness rejections, M.P.E.P. §2142 makes clear that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” and “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” The M.P.E.P. also notes the Supreme Court opinion that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Applicants respectfully submit that the Office has not provided the required “clear articulation of the reason(s) why the claimed invention would have been obvious” nor has it provided an “explicit analysis” to support the rejection. Thus, for at least these reasons, Applicants respectfully submit that the requirements of M.P.E.P. §804(II)(B)(1) and M.P.E.P. §2142 have not been met, that the rejection of claim 22 is insufficient to establish a *prima facie* case of obviousness, and that claim 22 is, therefore, not rendered unpatentable.

Applicants respectfully submit that claim 22 is allowable for at least an additional reason. Applicants respectfully note that the motivation asserted by the Office for combining the identified subject matter of the cited patents is not one that is generic in nature, but instead the Office rather specifically states that “one is motivated as such in order to provide a modular interface circuitry to transmit packets over plurality interchangeable interfaces to a network.” *Id.* at page 4. The source of this alleged motivation is not identified by the Office. Thus, **one may reasonably conclude that the motivation is taken from Applicants’ own disclosure, and is the result of impermissible hindsight.** According to M.P.E.P. §2142, “[t]o reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” In addition, the M.P.E.P. clearly states that “impermissible hindsight must be avoided and the legal conclusion **must be reached on the basis of the facts gleaned from the prior art.**” (emphasis added)

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness, as required by M.P.E.P. §804(II)(B)(1) and M.P.E.P. §2142, that claim 22, and any claims that depend therefrom, are not rendered unpatentable, and respectfully request that the rejection of claim 22 on the grounds of non-statutory obviousness-type double patenting be reconsidered and withdrawn.

With regard to independent claims 36 and 50, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness with respect to these claims as well, as required by M.P.E.P. §804(II)(B)(1) and M.P.E.P. §2142, that claims



36 and 50, and any claims that depend therefrom, are not rendered unpatentable, and respectfully request that the rejection of claims 36 and 50 on the grounds of non-statutory obviousness-type double patenting be reconsidered and withdrawn.

**II. Claims 23-32, 34, 35, 37-47, 49, 51-58, And 60 Are Not Rendered Unpatentable Over Claims 1-25 Of U.S. Patent No. 6,850,510 In View Of Claims 1-21 Of U.S. Patent No. 5,726,984 In Combination With Any Of Henley, Chan, Heath, Avery, And Sharman**

Claims 23, 24, 29-32, 34-37, 42-46, 49, 50, 54-57, and 60 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley and Chan. Claims 25, 26, 38, 39, 51, and 52 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Chan, and Heath. Claims 27, 28, 40, 41, and 53 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Heath, Chan, and Avery. Claims 47 and 58 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Chan, and Sharman. Applicants respectfully traverse the rejections.

Applicants respectfully submit that claims 23-35, 37-49, and 51-60 depend, respectively, from independent claims 22, 36, and 50. Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obvious that renders claims 22, 36, and 50 unpatentable, and that claims 22, 36, and 50 are allowable over the

proposed combinations of references, in that the Office has not shown how and why any of Henley, Chan, Heath, Avery, and Sharman remedy the deficiencies set forth above with respect to the rejections of claim 22, 36, and 50. Applicants respectfully submit that because claims 22, 36, and 50 are allowable, claims 23-35, 37-49, and 51-60 that depend from allowable claims 22, 36, and 50 are also allowable.

Further, Applicants respectfully submit that dependent claims 23-35, 37-49, and 51-60 are also allowable in that the Office has failed to meet the requirements of M.P.E.P. §804(II)(B)(1) and M.P.E.P. §2142 in the rejections of these claims, for the reasons set forth above with respect to claims 22, 36, and 50. More specifically, the rejections of claims 23-32, 34, 35, 37-47, 49, 51-58, and 60 suffer from the same failure to make clear, “[t]he differences between the inventions defined by the conflicting claims” by comparing “a claim in the patent compared to a claim in the application,” as required by M.P.E.P. §804(II)(B)(1). As in the rejections of claims 22, 36, and 50, the Office does not provide “[t]he reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent,” also as required by M.P.E.P. §804(II)(B)(1). In addition, the Office fails to provide the “explicit analysis” and “articulated reasoning” required by M.P.E.P. §2142 to support the legal conclusion of obviousness. Instead, the rejections simply repeat the text of Applicants’ claims, identify a portion of the cited art, and provide the conclusory statement “[t]herefore it would have been obvious....” Applicants respectfully submit that the rejections do not meet the requirements of M.P.E.P. §804(II)(B)(1) and M.P.E.P. §2142, that the Office has not established a *prima facie* case of obviousness with respect to

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any of claims 23-32, 34, 35, 37-47, 49, 51-58, and 60, and that claims 23-32, 34, 35, 37-47, 49, 51-58, and 60 are not rendered unpatentable. Therefore, Applicants respectfully submit that claims 23-32, 34, 35, 37-47, 49, 51-58, and 60 are independently allowable. Accordingly, Applicants respectfully request that the rejections of claims 23-32, 34, 35, 37-47, 49, 51-58, and 60 on the grounds of non-statutory obviousness-type double patenting be reconsidered and withdrawn.

### **Conclusion**

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-60 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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